

REMARKS

This application has been reviewed in light of the Office Action mailed March 23, 2006. Reconsideration of this application in view of the below remarks is respectfully requested. 1, 3, 5-18, 20-21 and 23-29 are currently pending with Claims 1, 3, 6, 7, 8, 11, 16, 18, 23, 24, 25, 26, 28 and 29 being in independent form. Claims 1, 6-7, 11-15, 23-24 and 26-17 have been previously withdrawn. By the present amendment, Claims 3, 8 – 10, 16 – 18, 20, 21, 25, 28 and 29 have been amended and Claims 30 and 31 are newly added. No new subject matter has been introduced into the disclosure by way of the present amendment.

Initially, Claims 3, 8 – 10, 16 – 18, 20, 21, 25, 28 and 29 have been amended to correct typographical errors. Specifically, Claims 3, 8 – 10, 16 – 18, 20, 21, 25, 28 and 29 recite the phrase: “User Equipment” throughout, however, properly, the phrase should not be capitalized. Therefore, “User Equipment” has been amended to read as “user equipment”.

I. Rejection of Claim 25 Under 35 U.S.C. § 112, Second Paragraph

Claim 25 is rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. Specifically, Claim 25 recites the limitation “a User Equipment” in line 2 and line 4. According to the Examiner, it is unclear whether these limitations refer to the same feature or different features, thus making the claims indefinite.

In response Claim 25 has been amended to recite: “...means for receiving by a user equipment a first list including a plurality of unique network identifiers; means for comparing by the user equipment the received first list with a second list which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment for selectively communicating with at least one of a plurality of networks...” thus removing the ambiguity with respect to the user equipment.

Accordingly, Applicant respectfully requests withdrawal of the rejection with respect to Claim 25 under 35 U.S.C. § 112, second paragraph.

II. Rejection of Claims 28 and 29 Under 35 U.S.C. § 102(e)

Claims 28 and 29 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,148,197 issued to Bridges et al.

Bridges et al. discloses a mobile station receiving a wireless carrier's identity, and comparing the received wireless carrier's identity with preferred wireless identities that are maintained in the mobile station. (See: col. 6, line 66 to col. 7, line 5).

The mobile station disclosed in Bridges et al. compares the received single identity against the plurality of identities maintained on the mobile station. Consequently, the mobile station of Bridges et al. does not compare a received list containing a plurality of network identifiers against a second list, which includes at least one network identifier, and is stored on the user equipment to identify at least one network for handover, as recited in Applicant's amended Claim 28, and similarly recited in amended Claims 3, 8, 16, 18, 25 and 29.

It is well-settled by the Courts that "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company, et al.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir., 1984).

Therefore, as demonstrated above, because Bridges et al. does not disclose each and every element recited in the present claims, Applicant respectfully submits that the rejection has been obviated. Accordingly, Applicant respectfully requests withdrawal of the rejection with respect to Claims 28 and 29 under 35 U.S.C. § 102(e).

III. Rejection of Claims 3 and 25 Under 35 U.S.C. § 103(a)

Claims 3 and 25 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 5,940,761 issued to Tiedemann, Jr. et al. in view of Bridges et al.

Tiedemann, Jr. et al. teaches a method for performing mobile assisted handoff between communication systems having a system preference table. However, Tiedemann, Jr. et al. does not overcome the above-identified deficiencies in Bridges et al. Specifically, Tiedemann, Jr. et al. does not disclose or suggest a means for comparing a first list having a plurality of network identifiers and received by a user equipment from an active network, against a second list, internally stored in the user equipment.

Therefore, for at least the reasons given above, Claims 3 and 25 are believed to be patentably distinct and allowable over the cited prior art references. Accordingly, Applicant respectfully requests withdrawal of the rejection with respect to Claims 3 and 25 under 35 U.S.C. § 103(a) over Tiedemann, Jr. et al. in view of Bridges et al.

IV. Rejection of Claims 16 - 18 and 20 Under 35 U.S.C. § 103(a)

Claims 16 - 18 and 20 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 6,223,030 issued to Van Den Heuvel et al. in view of Bridges et al.

Van Den Heuvel et al. fails to overcome the deficiencies identified in Bridges et al. Specifically, Van Den Heuvel et al. does not disclose or suggest a means for comparing a first list having a plurality of network identifiers and received by a user equipment from an active network, against a second list, internally stored in the user equipment.

Therefore, for at least the reasons given above, Claims 16 – 18 and 20 are believed to be patentably distinct and allowable over the cited prior art references. Accordingly, Applicant

respectfully requests withdrawal of the rejection with respect to Claims 16 – 18 and 20 under 35 U.S.C. § 103(a) over Van Den Heuvel et al. in view of Bridges et al.

V. Rejection of Claim 5 Under 35 U.S.C. § 103(a)

Claim 5 is rejected under 35 U.S.C. §103(a) as allegedly obvious over Tiedemann, Jr. et al. in view of Bridges et al., and further in view of U.S. Patent No. 6,272,315 issued to Chang et al.

Chang et al. discloses a mobile satellite system and terrestrial wireless system networking technique for switching a mobile unit between a mobile satellite system mode and a terrestrial wireless system mode. Additionally, Chang et al. teaches adding a system ID of a network to the bottom of a list of system IDs stored in a memory of a mobile terminal. However, Chang et al. fails to overcome the above-identified deficiencies present in Tiedemann, Jr. et al., Van Den Heuvel et al. and Bridges et al.

Therefore, for at least the reasons given above, Claim 5 is believed to be patentably distinct and allowable over the cited prior art references. Accordingly, Applicant respectfully requests withdrawal of the rejection with respect to Claim 5 under 35 U.S.C. § 103(a) over Tiedemann, Jr. et al. in view of Bridges et al., and further in view of Chang et al.

VI. Rejection of Claims 8 – 10 Under 35 U.S.C. § 103(a)

Claims 8 – 10 are rejected under 35 U.S.C. §103(a) as allegedly obvious over Van Den Heuvel et al. in view of Bridges et al., and further in view of Chang et al.

As presented above, Chang et al. fails to overcome the above-identified deficiencies present in Van Den Heuvel et al. and Bridges et al. Therefore, for at least the reasons given above, Claims 8 – 10 are believed to be patentably distinct and allowable over the cited prior art references. Accordingly, Applicant respectfully requests withdrawal of the rejection with respect

to Claims 8 – 10 under 35 U.S.C. § 103(a) over Van Den Heuvel et al. in view of Bridges et al., and further in view of Chang et al.

VII. Rejection of Claim 21 Under 35 U.S.C. § 103(a)

Claim 21 is rejected under 35 U.S.C. §103(a) as allegedly obvious over Van Den Heuvel et al. in view of Bridges et al, in further view of U.S. Patent No. 6,584,116 issued to Gourgue et al. Claim 21 depends from Independent Claim 16 and thus includes the limitations recited in that independent claim.

Gourgue et al. discloses a UMTS network and a GSM network, and a method of handover to a GSM network from a UMTS network during a call originating in a UMTS network. However, Gourgue et al. fails to overcome the above-identified deficiencies present in Van Den Heuvel et al. and Bridges et al.

Therefore, for at least the reasons given above, Claim 21 is believed to be patentably distinct and allowable over the cited prior art references. Accordingly, Applicant respectfully requests withdrawal of the rejection with respect to Claim 21 under 35 U.S.C. § 103(a) over Van Den Heuvel et al. in view of Bridges et al., and further in view of Gourgue et al.

VIII. Newly Added Claims 30 and 31


Newly added Claims 30 and 31 recite: "...the network identifier in the second list is an identifier of a network that is not used..." which finds support on page 8, lines 12 – 15 of the specification as originally filed. Therefore, no new subject matter has been introduced into the disclosure by way of newly added Claims 30 and 31.

CONCLUSIONS

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims presently pending in the application, namely, Claims 3, 5, 8 – 10, 16 – 17, 18, 20 – 21, 25, and 28 – 31 are believed to be in condition for allowance and patentably distinguishable over the art of record.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call Applicant's undersigned attorney at the number indicated below.

Respectfully submitted,


Paul J. Esatto, Jr.
Registration No. 30,749

SCULLY, SCOTT, MURPHY & PRESSER, P.C.
400 Garden City Plaza - Ste. 300
Garden City, New York 11530
(516) 742-4343

PJE:DAT:jam:ej